



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/989,274

11/20/2001

Akihiko Nagata

F-7229

3158

28107

7590

11/03/2004

JORDAN AND HAMBURG LLP
122 EAST 42ND STREET
SUITE 4000
NEW YORK, NY 10168

EXAMINER

HOLLOWAY III, EDWIN C

ART UNIT

PAPER NUMBER

2635

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/989,274	Applicant(s) NAGATA ET AL.	
	Examiner Edwin C. Holloway, III	Art Unit 2635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20040407</u> | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2635

EXAMINER'S RESPONSE

1. In response to the application filed 20 November 2001, the application has been examined. The examiner has considered the presentation of claims in view of the disclosure and the present state of the prior art. And it is the examiner's opinion that the claims are unpatentable for the reasons set forth in this Office action:

Claim Rejections - 35 USC § 102 & 103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to

Art Unit: 2635

point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1 and 2 rejected under 35 U.S.C. 102(b) as being anticipated by Stein (DE 3618464). Regarding claim 1, Stein discloses a remote control transmitter 2 data generation device in the form of control data generation device 10 and identification information (address) generation device 8. The transmitter includes a first transmission section 6 for transmitting control data and a second (auxiliary) transmission section 14 for transmitting a identification information (address) and having a limited range corresponding to a different transmission destination area compared to the first section 6. The transmitter 2 acts as a transmission section change device because the address allocation occurs prior to the control. See the English language abstract by Derwent. Regarding claim 2, the first section 6 is in the front (top), and the second section 14 in the back (bottom) in fig. 1.

6. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stein (DE 3618464) as applied above in combination with Burgmann (US 5077547). Stein lacks the second section in a concave portion of claim 3 and lid of claim 4. Burgmann discloses non contact programmer with a concave recess

Art Unit: 2635

33 for receiving a device to be programmed. Fig. 2 shows the recess with a corresponding lid. The purpose is to avoid interference. See col. 1 lines 41-49 and col. 4 lines 62-68. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the recess and lid of Burgmann in the transmitter of Stein because Burgmann discloses the purpose of avoiding interference.

7. Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stein (DE 3618464) as applied above in combination with Shinozuka (US 5334076). Stein lacks the second section in a concave portion of claim 3 with charging terminal of claim 5. Shinozuka discloses a transmitter with a concave recess including charging terminals 25 in fig. 2 for receiving a device to be recharged. See the abstract, col. 2 lines 16-22 and col. 3 lines 31-40. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the recess and charging terminals of Shinozuka in the transmitter of Stein for easy connection to terminals for supplying power to the controlled device.

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stein (DE 3618464) as applied above in combination with Lindmayer (US 5355525) Lindmayer discloses a remote control transmitter for controlling drives with first and

Art Unit: 2635

second infrared transmission sections 5 and 6. The second section 6 operates at reduce range. See col. 3 line 29 - col. 4 line 13. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the infrared transmitters of Lindmayer in the device of Stein because Stein suggests reduced range and opto-electronic transmission.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wrege (US 3639755) discloses a remote control transmitter for locomotive with address assignment. Rosenhagen (US 4334221) and DeAngelis disclose plural remotes for selectively controlling plural toys.

CONTACT INFORMATION

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact an Electronic Business Center (EBC) representatives at 703-305-3028 or toll free at 866-217-9197 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at ebc@uspto.gov. The Patent EBC is a complete customer service center that supports all Patent e-business products and service applications. Additional information is available on the Patent EBC Web site at <http://www.uspto.gov/ebc/index.html>.


Any inquiry of a general nature should be directed to the Technology Center 2600 receptionist at (571) 272-2600.

Art Unit: 2635

Facsimile submissions may be sent via fax number (703) 872-9306 to customer service for entry by technical support staff. Questions regarding fax submissions should be directed to customer service voice line (703) 306-0377.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin C. Holloway, III whose telephone number is (571) 272-3058. The examiner can normally be reached on M-F (8:30-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (571) 272-3068.

EH
10/31/04


EDWIN C. HOLLOWAY, III
PRIMARY EXAMINER
ART UNIT 2635